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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/105,840	06/26/1998	DAVID BILL	TDS-001	6055
26171 7590 08/31/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER PHAN, MAN U	
			ART UNIT 2616	PAPER NUMBER
			MAIL DATE 08/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/105,840

Applicant(s)

BILL, DAVID

Examiner

Man Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-9,12-15 and 18-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27,29 and 72-85 is/are allowed.
- 6) ☒ Claim(s) 1-3,6-9,12-15,18-20,24-26,28,30,34-50,54-71 and 86-92 is/are rejected.
- 7) ☒ Claim(s) 21-23,31-33 and 51-53 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. In view of the appeal brief filed on 11/14/2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols @, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the reference

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label from each block as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 32, 35 are objected to because of the following informalities:

Claims 32, 35 are method claims while depend on system claims 24, 30. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 54-71 and 86-92 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically, as directed to “computer program product” or “a software routine”. The claimed “computer program” product or “software routine” of claims 54-71 and 86-92 is non-statutory as at no time in the claim does applicant define the software routine. A computer program per se is not in one of the statutory categories. A computer program must be claimed in combination with an appropriate computer readable medium so that the program is capable of producing a useful, concrete and tangible result when used in a computer system

Claims 54-71 and 86-92 are direct to “a computer program product” which is not supported by either a specific asserted utility or a well established utility. Claims 54-71 and 86-92 merely defines “*a computer program product*” or “*data record for storing instructions*”, and is not directed to statutory subject matter. The claims appear to be nothing more than a signal not tangibly embodied in a manner so as to be executable and thus non-statutory for failing to be in one of the categories of invention. It’s not tangibly embodies and non-functional descriptive material - data per se. Therefore, what applicant is attempting to claim as a computer program product or data record as is known in the art. The claim is actually drawn to non-functional descriptive material stored on a machine readable medium. The description given in the specification does not cure this problem. In practical terms, claims define non-statutory

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processes if they simply manipulate abstract ideas, e.g., a bid or a bubble hierarchy, without some claimed practical application, Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59; Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. Any claim not directly rejected on 35 U. S. C. 101 stands rejected due to its dependency.

7. Claims 54-71 and 86-92 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 6-9, 12-15, 18-26, 28, 30-53, 72-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett et al. (US#6,005,597) in view of Kindo et al. (US#6,363,383).

With respect to claims 24-26, 28, 30, 35, the references disclose a novel system and method for distributing personalized information, according to the essential features of the claims. Barrett et al. (US#6,005,597) discloses in Fig. 8 a block diagram of an embodiment of a process that is used for determining viewer's program interest or "score" for a program, in which information in a viewer profile is used to obtain an estimated measure ("score") of the viewer's

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predicted interest in currently available programs so as to be able to rank the available programs in order of predicted viewer interest (*determining a score for the content elements responsive to a predicted interest*). Any of a large variety of well known analytical techniques can be used (Col. 7, lines 50 plus and Col. 171, lines 2 plus).

However, Inagaki does not disclose expressly the step of comparing the score with a selected threshold. In the same field of endeavor, Kindo et al. (US#6,363,383) teaches in Fig. 1 a functional block diagram of an information filtering system according an embodiment of the present invention, in which the access control unit 14 for controlling access to the information by *comparing the score signal with a threshold* determined in advance (Col. 1, lines 43 plus, and Col. 3, lines 8 plus).

Regarding to claims 1-3, 6-9, 12-15, 18-20, 34, they are method claims corresponding to the system claims 24-26, 28, 30, 35 as discussed in paragraph above. Therefore, claims 1-3, 6-9, 12-15, 18, 19, 34 are analyzed and rejected as previously discussed with respect to claims 24-26, 28, 30, 35.

Regarding to claims 36-50, they are means claims corresponding to the system claims 24-26, 28, 30, 35 as discussed in paragraph above. Therefore, claims 36-49 are analyzed and rejected as previously discussed with respect to claims 24-26, 28, 30, 35.

One skilled in the art of communications would recognize the need for distributing personalized content to potentially large numbers of recipients, and would apply Kindo's comparing the score with a selected threshold into Barrett's novel use of the predicted interest in selecting program. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Kindo's information filtering for selectively

limiting access into Barrett's method and apparatus for program selection with the motivation being to provide a system and method for distributing personalized content.

Allowable Subject Matter

10. Claims 27, 29, 72-85 are allowable.

11. Claims 21-23, 31-33, 51-53 are objected to as being dependent upon the rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims, and if rewritten or amended to overcome the objection(s) set forth in this Office action.

12. The following is an examiner's statement of reasons for the indication of allowable subject matter: The closest prior art of record fails to disclose or suggest wherein a system including: a plurality of scores for content elements in a set of content elements in a pool, said scores being responsive to a predicted interest by an individual recipient of said one content element to a recipient; a result of comparing said scores with a selected threshold; an adjusted threshold, said adjusted threshold being determined in response to said result for comparing; a communication path disposed for coupling said one content element to said individual recipient, in response to said result of comparing; and a selected one of said content elements, said selected one being in response to said scores and said adjusted threshold; selecting a new pool that differs from the pool, wherein the new pool is in response to replacing the pool entirely, and wherein the new pool includes an individual content element added to the pool, and

excludes an individual content element removed from the pool, as specifically recited in the claims.

13. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Ukai et al. (US#7,096,486) is cited to show the TV program selection support system.

The Liebenow (US#6,530,083) is cited to show the system for personalized settings.

The Kindo et al. (US#7,162,487) is cited to show the information filtering system and information filtering method.

The Kindo et al. (US#6,687,703) is cited to show the information filtering system and information filtering method.

The Brown et al. (US#2007/0174866) is cited to show the rule-base playlist engine.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149. The examiner can normally be reached on Mon - Fri from 6:00 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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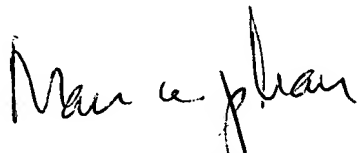
supervisor, Jay Patel, can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

07/31/2007.


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PRIMARY EXAMINER